

Remarks

The Office Action mailed December 18, 2006 has been carefully reviewed and the following amendment is submitted in consequence thereof.

Claims 1-7 and 9-29 are now pending in this application, of which claims 1, 9, 23 and 28 are amended. Claim 8 is cancelled without prejudice or disclaimer, and claim 29 is newly added. It is respectfully submitted that the pending claims define allowable subject matter.

As requested in the Office Action, the specification has been reviewed in detail and has been amended to correct, among other things, the reference numerals in the specification.

Applicants will now respond to the issues noted in the Office Action in the order set forth therein.

I. The Priority Claim and Incorporation by Reference

Applicants are now claiming the benefit of the provisional parent application as suggested by the Examiner, and incorporation by reference in the specification has been deleted.

With respect to the incorporation by reference of the disclosure of U.S. Application Serial No. 10/238,390 in the specification, the disclosure of U.S. Application Serial No. 10/238,390 is not believed to include essential material to the invention presently being claimed, and the disclosure of U.S. Application Serial No. 10/238,390 is not presently being relied upon to overcome any objection, rejection or any requirement imposed by the Office. Thus, as far as the present prosecution is concerned, no action is believed to be necessary at this time.

II. The Drawing Objections

The objection to the drawings under 37 C.F.R. § 1.83(a) is respectfully traversed. Claim 8 is cancelled and the objection has been rendered moot.

The objection to the drawings under 37 C.F.R. § 1.84(p)(5) is respectfully traversed. The specification has been amended in a manner that is believed to render the noted issues in the Office Action moot as briefly explained below.

Reference numeral “(119)” has been deleted from the specification.

Instances of “upper portion (405)” in the specification have been corrected to read “upper portion (145)” as originally intended.

It is believed that the “the first axis of rotation 103” as denoted in the Office Action is in error. This is not found in Applicants file copy of the application.

References to distal ends (136) in the specification have been removed from the specification.

References to bore hole (613) have been removed from the specification, as well as references to bearing surfaces (413) and the images (501) and (503).

Applicants accordingly request that the objections to the drawings be withdrawn.

III. The § 112 Rejections

The rejections of claims 1-28 under 35 U.S.C. § 112, ¶ 2 is respectfully traversed.

Under 35 U.S.C. § 112 ¶ 2, the specification shall conclude with one or more claims “particularly pointing out and distinctly claiming what the applicant regards as his invention”, often referred to as the definiteness requirement. Whether claim language is sufficiently definite depends on whether one skilled in the art would understand the scope of that language when read in light of the patent specification. In re Morris, 127 F.3d 1048, 1056, 44 USPQ2d 1023, 1029 (Fed. Cir. 1997); In re Zletz, 893, F.2d 319, 13 USPQ2d 1320 (Fed. Cir. 1989).

It is asserted in the Office Action that claims 1-28 do not recite structure to effect the function of the handle. Applicants respectfully submit that this is not a basis for a § 112 ¶ 2 rejection, as § 112 ¶ 2 neither mandates that the claims be enabling nor requires structure to be recited. Rather § 112 ¶ 2 only requires that the scope of the claim be understood by one skilled

in the art. It is well established that a patent applicant is free to recite features of an apparatus either structurally or functionally. In re Schreiber, 44 USPQ2d 1429, 1432 (Fed. Cir. 1997); In re Swinheart, 169 USPQ 226, 228 (CCPA 1971). In construing a patent claim for examination, it is improper to ignore functional recitations. Pac-Tec, Inc. v. Amerace Corp., 14 USPQ2d 1871, 1876 (Fed. Cir. 1990); In re Venezia, 189 USPQ 149 (CCPA 1976). In a proper construction of the claims, *all* recitations of the claims must be considered. See MPEP § 2143.03 (all words in a claim must be considered in judging the patentability of the claim against the prior art). The scope of the present claims, including functional aspects thereof, are submitted to be readily ascertainable and understood by those in the pertinent art. Consequently, claims 1-28 are submitted to meet the requirements of § 112 ¶ 2.

Applicants accordingly request that the rejection of the claims under § 112 ¶ 2 be reconsidered and withdrawn.

IV. The Prior Art Rejections

The prior art rejections will now be considered in the order set forth in the Office Action.

A. Lu '344

The rejection of claims 1-4, 6 and 7 under 35 U.S.C. § 102(a) as being unpatentable over Lu '344 is respectfully traversed.

Attached herewith is a copy of a Declaration Under 37 CFR § 1.132 that was prepared and submitted in the prosecution of another commonly owned patent application (namely U.S. Patent Application Serial No. 10/238,390), but that it is believed to equally applicable in purpose and effect for the present case. Applicants specifically call the Examiners attention to paragraphs 3-17 and 19-21 of the Declaration and associated appendices as evidence that the invention disclosed in the Lu '344 patent was derived from the previous work of one of the present inventors. Applicants specifically note that U.S. Patent Application Serial No. 10/238,390 for which the subject Declaration was originally prepared, and also the present application, each list James O'Shea as an inventor and the factual evidence of the Declaration

therefore directly applies to the instant prosecution. The facts set forth in the Declaration are therefore pertinent to the present application and should be considered.

Applicants submit that the Declaration establishes that the inventor of the Lu '344 patent was associated with one of the present Applicants (namely Mr. O'Shea) and learned of the invention disclosed in the Lu '344 patent from Mr. O'Shea's prior work. The Lu '344 disclosure is therefore a description of one of the Applicants' (Mr. O'Shea's) own prior work. M.P.E.P § 716.10 provides that an uncontradicted, unequivocal statement in a 1.132 submission that an Applicant invented the subject matter disclosed in a reference will be accepted as establishing inventorship. The 1.132 submissions is directly authorized in M.P.E.P § 2136.05, and the requirements thereof are believed to be met to disqualify the Lu '344 reference as prior art to the present application.

Applicants accordingly request that the rejection of claims 1-4, 6 and 7 under 35 U.S.C. § 102(a) be reconsidered and withdrawn in light of the Declaration.

B. Bellini '687

The rejection of claims 9-11 and 24-27 under 35 U.S.C. § 102(b) as being unpatentable over Bellini '687 is respectfully traversed.

Claim 9 has been amended to now recite, among other recitations, that "in said retracted position, said grip portion is arranged so said principal dimension is generally perpendicular to said wheel rotation axis." Bellini does not disclose at least this recitation, in combination with the other recitations of claim 9. Rather, as explicitly shown and described in relation to Figure 4 of the Bellini reference, the principal dimension of the Bellini hand grip is located parallel to the wheel rotation axis. Bellini therefore does not anticipate claim 9.

Claims 10, 11, and 24-27 depend from claim 9, and when the recitations of these dependent claims are considered in combination with the recitations of claim 9, claims 10, 11, and 24-27 are also not anticipated by the Bellini '687 reference.

Applicants accordingly request that the rejection of claims 9-11 and 24-27 under 35 U.S.C. § 102(b) be reconsidered and withdrawn.

C. Lu '055

The rejection of claims 9-16 and 24-27 under 35 U.S.C. § 102(e) as being unpatentable over Lu '055 is respectfully traversed.

Lu '055 does not disclose, as recited in independent claim 9, a piece of luggage defining a receptacle and a handle having a grip portion “wherein said grip portion is nested in said receptacle when in the retracted position.” Lu '055 is therefore not an anticipating reference for claim 9.

Claim 11-16 and 24-27 depend from claim 9, and when the recitations of these dependent claims are considered in combination with the recitations of claim 9, claims 11-16 and 24-27 are also not anticipated by the Lu '055 reference.

Applicants accordingly request that the rejection of claims 9-16 and 24-27 under 35 U.S.C. § 102(e) be reconsidered and withdrawn.

D. Lu '055 in view of Shafer '064

The rejection of claims 1-8 and 17-23 under 35 U.S.C. § 103(a) as being unpatentable over Lu '055 in view of Shafer (DE 3636064) is respectfully traversed.

Applicants note that the Shafer reference is a foreign language reference, and unless Applicants are provided an English translation of the Shafer disclosure, such a rejection would be procedurally improper. MPEP § 706.02 states that if a document is in a language other than English, and if the Examiner seeks to rely upon that document, a translation must be obtained so that record is clear as to the precise facts that the Examiner is relying upon in support of the rejection. A translation of the Shafer document has not been provided, and Applicants request reconsideration of the present rejections on this procedural ground.

The Office Action states the following with respect to the Shafer '064 reference:

To have secured the handle of Lu to a parallelepiped case with the handle oriented along the top of the case in the manner taught by Schafer would have been obvious to one of ordinary skill in the art.

See Office Action dated December 18, 2006 page 7. Applicants submit, however, that this comment bears no clear relation to either of independent claims 1 or 9, and instead appears to be directed toward dependent claims 17-20. The United States Supreme Court has recently held that obviousness rejections must be supported with "articulated reasoning with some rational underpinning to support the conclusion of obviousness." See KSR International Co. v. Teleflex, Inc., slip Opinion at page 14. The present rejection does not appear to meet this standard as it reflects no articulate reasoning *why* the independent or dependent claims are believed to be obvious, but rather is stated in the form of a conclusion of obviousness. Additionally, all the cited references disclose handles oriented along the top of the case, so *why* the Shafer reference is being singled out as pertinent to the claimed invention is far from clear. Applicants accordingly request specific explanation and articulation regarding the reasoning and rational underpinning for any obviousness rejection of the claims.

Notwithstanding the procedural issues noted above, in the interest of furthering the present prosecution, Applicants will proceed to comment on the substance of the rejection in the event that it is helpful to the Examiner. Applicants respectfully submit that the Shafer reference, insofar as it is understood from the Figures and the English language abstract, appears to teach away from the invention claimed and also from the invention of the Lu '055 reference.

Shafer appears to describe a suitcase (10) having wheels and which may be used as a "scooter." A pivoting wheel (26) is provided on one corner of the case, and a tread member (58) is integrated into the side of the suitcase (10). A holding member is provided for steering or pivoting the wheel (26), and the holding member includes a shaft (36) and handlebar portions (40) and (42) extending perpendicularly from an axis of the shaft (36). The portion (42) is movable between a folded position and an extended position for steering the suitcase.

It bears noting that the Shafer case, being configured as a scooter, would not require a towing arm at all, nor would it include anything that would be fairly characterized as a towing arm. To use the Shafer case as a scooter, which Shafer appears to explicitly teach, the user would place one foot on the tread member (58) and propel the case with the user's other foot. In such a manner, the case is not being towed, but rather propelled or pushed.

The Shafer case is ill suited for towing purposes as the wheels (26) and (28) are provided on only one side of the case, and the shaft (36) is located at one of the corner's of the case such that the case would be, by design, unbalanced in terms of weight and geometry. Couple all this with the movable or pivotal front wheel (26) and one can only imagine how difficult the Shafer case would be to tow. The disclosures of the Shafer invention and the invention of the Lu '055 patent are therefore inconsistent with one another and are believed to teach away from one another on material points of the invention. In view of these inconsistencies and incompatibilities, it is not believed that one of ordinary skill in the art would have combined features of the Lu '055 and the Shafer '064 inventions, or that one of ordinary skill in the art would have considered the Shafer '064 reference to add anything to the teaching of the Lu '055 patent with respect to towable handle structures.

Accordingly, Applicants request that the § 103(a) rejection of claims 1-8 and 17-23 be reconsidered and withdrawn.

E. Shafer '064 or Maloney '925

The rejection of claim 28 under 35 U.S.C. § 102(b) as being anticipated by Shafer '064 or Maloney '925 is respectfully traversed.

Claim 28 recites a hand towed piece of luggage comprising: "a piece of luggage arranged to generally be a parallelepiped and having a top face and a bottom face on opposite sides thereof, a pair of wheels connected to the piece of luggage toward said bottom face thereof, said pair of wheels having a fixed wheel rotation axis; a towing arm including a telescoping pole, said pole having a length with opposite proximal and distal ends, said distal end of said pole being arranged to move from a retracted position to an extended position; and a towing handle

connected to said distal end of said towing arm so as to be able to rotate about said distal end of said towing arm, said towing handle including a grip portion with a principal dimension; wherein, in said retracted position, said grip portion is arranged so said principal dimension is generally perpendicular to said wheel axis and said principal dimension is generally parallel to said top face.

Claim 28 is not believed to be anticipated by or obvious over either Shafer '064 or Maloney '925. Shafer does not disclose a pair of wheels having a fixed rotation axis, but rather discloses a first wheel (26) that can pivot to adjust the rotation axis and steer the suitcase and a second wheel (28) with a fixed rotation axis to follow the direction of the first wheel. To modify the Shafer suitcase to fix the rotation axes of each of the wheels (26) and (28) would render the suitcase impossible to steer and would make the Shafer suitcase inoperable for its intended purpose.

Maloney '925 does not teach a telescoping pole as claim 28 recites, but rather teaches a pivotal handle construction of a fixed length. It appears that a telescoping pole would defeat the advantages of the invention disclosed by Maloney.

Neither Shafer '064 or Maloney '925 discloses or suggests a "towing handle operatively connected to said distal end of said towing arm for pivoting movement of said towing handle about at least two pivot axes relative to said distal end of said pole in said extended position" as claim 28 recites. Rather, each disclose towing handles that are rotatable about a single axis.

Claim 28 is therefore submitted to be patentable over Shafer '064 and Maloney '925.

Accordingly, Applicants request that the § 102(b) rejection of claim 28 be reconsidered and withdrawn.

F. New Claim 29

Claim 29 is believed to be patentable over the cited art for at least for similar reasons to the other dependent claims discussed in detail above.

V. Conclusion

In view of the foregoing remarks, all the claims now active in this application are believed to be in condition for allowance. Reconsideration and favorable action is respectfully solicited.

Respectfully Submitted,



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